

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 24-28 have been added. Thus, claims 12-28 are pending in the patent application, of which claims 12, 15, 18, 19 and 24 are independent.

**Noted – Priority Document Received by USPTO**

The indication (see attachments to the Office Actions mailed March 19, 2004, box 12(a)(1) as checked) that certified copy of the priority document has been received by the USPTO in noted with application.

**Noted – IDS considered**

The indication (see attachments to the Office Actions mailed, March 19, 2004, December 13, 2005, February 21, 2007, April 16, 2007 and October 22, 2007) that the Information Disclosure Statements (IDS) as filed on February 9, 2000, September 27, 2005, June 7, 2006, October 30, 2006, July 17, 2007 and September 4, 2007 and references listed therein have been considered is noted with application.

**Approval of Drawings Requested**

Drawings were submitted on February 10, 2000. To date, no official indication of approval of the drawings has been noted in the prosecution history. The undersigned has no reason to believe that this circumstance implies anything other than a minor oversight on the part of the USPTO. Accordingly, official approval of the drawings is hereby respectfully requested.

**Claim Rejections Under 35 U.S.C. §112**

Claims 12-17 and 19-23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. By the foregoing amendments, the claims have been amended to more particularly point out and distinctly claim their subject matter. Accordingly, withdrawal of the rejection is respectfully requested.

**Claim Rejection Under 35 U.S.C. §102**

Claims 12, 13, 19, 21, 22 are rejected under 35 U.S.C. §102(a) as being anticipated by Achour et al. (US 6,363,260 B1).

**INDEPENDENT CLAIM 12**

As an example, independent claim 12 recites (among other things) a feature of:

...

*measuring communication performances of communication between the communication device and the other communication device by communicating between the communication device and the other communication device in each of the plurality of different communication modes, under a plurality of different communication conditions for each of the different communication modes respectively;*

*determining, as a threshold, a communication condition that the corresponding measured communication performance of communication between the communication device and the other communication device in one of the communication modes exceeds a measured communication performance of communication in the other communication mode based on a result of the measurement;*

*selecting, before performing actual communication between the communication device and the other communication device under a certain communication condition, a communication mode that the communication performance of a communication between the communication device and the other communication device under the certain communication condition of the actual communication exceeds the communication performance of the other communication mode as an optimum communication mode, by comparing the communication condition of the actual communication and the determined threshold; ...*

The Office Action stated that "it exits the first service provider and monitors the pilot strength and the pilot received power of the other providers to find a better service provider system" is shown in figs.4 and 5 in Achour. It can be read that the first service provider is different from the better service provider. Therefore, Achour does not disclose "*measuring communication performances of communication between the communication device and the other communication device by communicating between the communication device and the other communication device in each of the plurality of different communication modes.*"

The Office Action stated that Achour discloses "if the first performance level falls below a first threshold or the second performance level falls below a second threshold, a timer started." However, Achour does not disclose comparing the first performance level with the second performance level. A first threshold level compared with the first performance level, and a second threshold level compared with the second performance level, are different threshold values. Further, with Achour, it is

determined whether the first performance level is above the first threshold level or not, and whether the second performance level is above the second threshold level or not. Here, the results of the two determinations have no relationship to each other. Therefore, Achour does not disclose "**determining, as a threshold, a communication condition that the corresponding measured communication performance of communication between the communication device and the other communication device in one of the communication modes exceeds a measured communication performance of communication in the other communication mode based on a result of the measurement**" and "**selecting, before performing actual communication between the communication device and the other communication device under a certain communication condition, a communication mode that the communication performance of a communication between the communication device and the other communication device under the certain communication condition of the actual communication exceeds the communication performance of the other communication mode** as an optimum communication mode, by comparing the communication condition of the actual communication and the determined threshold."

Achour discloses that "if both of these levels are below respective thresholds for over eight seconds, the phone switches to another network" in summary. However, none of "these levels" corresponds to any communication modes. Achour discloses that "... after the phone has initially connected to a CDMA wireless network, monitoring a level of total power received by the phone... If the power level remains below the threshold level... the dual-mode or dual-band phone switches to an AMPS or other network." However, Achour does not disclose that a communication performance of AMPS or other network is measured. Therefore, Achour discloses "the phone has initially connected to a CDMA wireless network." Achour does not disclose "*selecting, before performing actual communication between the communication device and the other communication device under a certain communication condition, a communication mode...*"

Claim 13 depend from Claim 12. A basis for how Achour is deficient vis-à-vis Claims 12 has been noted above.

Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggested each and every element of the claimed invention. In view of the distinction of Claim 12 noted above, at least one claimed element is not present in the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis Claims 12. Claim 13 ultimately depend from claim 12, and so at least similarly distinguish over the asserted combination of references.

**INDEPENDENT CLAIM 19**

As an example, independent claim 19 recites (among other things) a feature of:

...

*communicating , on a same communicating line, with the other communication device in both a first communication mode and in a second communication mode that is different from the first communication mode respectively, under a plurality of different communication conditions;*

*obtaining communication performances for each of the communications with the other communication device;*

*measuring a communication performance in the first communication mode, and a communication performance in the second communication mode under each of the different communication conditions;*

*determining, based on the communication performances measured under each of the different communication conditions, a communication condition in which a communication performance of the first communication mode exceeds a communication performance of the second communication mode; and*

*before starting communication with the other communication device in a particular communication condition, selecting, among the first communication mode and the second communication mode, a communication mode corresponding to a particular communication condition and the other communication device, for actually communicating with the other communication device under the particular communication condition, that the communication performance exceeds that of the other communication mode.*

The Office Action stated that "it exits the first service provider and monitors the pilot strength and the pilot received power of the other providers to find a better service provider system" is shown in figs.4 and 5 in Achour. It can be read that the first service provider is different from the better service provider. Therefore, Achour does not disclose "***communicating, on a same communicating line, with the other communication device in both a first communication mode and in a second communication mode that is different from the first communication mode respectively, under a plurality of different communication conditions***" and "***obtaining communication performances for each of the communications with the other communication device.***"

The Office Action stated that Achour discloses "if the first performance level falls below a first

threshold or the second performance level falls below a second threshold, a timer started." However, Achour does not disclose comparing the first performance level with the second performance level. A first threshold level compared with the first performance level, and a second threshold level compared with the second performance level, are different threshold values. Further, with Achour, it is determined whether the first performance level is above the first threshold level or not, and whether the second performance level is above the second threshold level or not. Here, the results of the two determinations have no relationship to each other. Therefore, Achour does not disclose "**determining, based on the communication performances measured under each of the different communication conditions, a communication condition in which a communication performance of the first communication mode exceeds a communication performance of the second communication mode.**"

Achour discloses that "if both of these levels are below respective thresholds for over eight seconds, the phone switches to another network" in summary. However, none of "these levels" corresponds to any communication modes. Achour discloses that "... after the phone has initially connected to a CDMA wireless network, monitoring a level of total power received by the phone... If the power level remains below the threshold level... the dual-mode or dual-band phone switches to an AMPS or other network." However, Achour does not disclose that a communication performance of AMPS or other network is measured. Achour discloses "the phone has initially connected to a CDMA wireless network." Therefore, Achour does not disclose "**before starting communication with the other communication device in a particular communication condition, selecting, among the first communication mode and the second communication mode, a communication mode corresponding to a particular communication condition and the other communication device, for actually communicating with the other communication device under the particular communication condition, that the communication performance exceeds that of the other communication mode.**"

Claims 21-22 depend from Claim 19. A basis for how Achour is deficient vis-à-vis Claims 19 has been noted above.

Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggested each and every element of the claimed invention. In view of the distinction of Claim 19 noted above, at least one claimed element is not present in the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis Claims 19. Claims 21-22 ultimately depend from claim 19, and so at least similarly distinguish over the asserted combination of references.

Accordingly, withdrawal of the rejection is respectfully requested.

**Claim Rejection Under 35 U.S.C. §103**

Claims 14, 15, 18 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Achour in view of Vembu (US 6,259,928 B1).

Claims 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Achour in view of Vembu and Liu (US 6,252,900 B1).

Claims 14, 23 and 20 depend from Claims 12 and 19, respectively. A basis for how Achour is deficient vis-à-vis Claims 12 and 19 has been noted above. The Office Action does not rely upon Vembu to compensate for these deficiencies. Hence, the noted feature of Claims 14 and 20 also is a distinction over Vembu.

Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggested each and every element of the claimed invention. In view of the distinction of Claims 12 and 19 noted above, at least one claimed element is not present in the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis Claims 12 and 19. Claims 14 and 20 ultimately depend from claims 12 and 19, respectively, and so at least similarly distinguish over the asserted combination of references.

In view of the foregoing discussion, the rejection of Claims 14 and 19 is improper. Accordingly, withdrawal of the rejection is respectfully requested.

**INDEPENDENT CLAIM 15**

As an example, independent claim 15 recites (among other things) a feature of:

...

*a unit that measures performances of a communication between the communication device and one of the other communication device in each of the different communication modes, under the different communication data sizes respectively, for each of the other communication devices;*

*a unit that determines, for each of the other communication device, a communication data size that a communication performance of a communication between the other communication device in a first communication mode exceeds a communication performance of communication in a second communication mode and set the determined communication data size as a threshold for the other communication device; and*

*a unit that selects one of the communication modes that the corresponding*

*communication performance exceeds the communication performance of the other communication mode in an actual communication under a particular communication data size between a particular communication device under a particular communication condition.*

As will be explained below, at least these features of claim 15 are a distinction over Achour, and thus over its combination with Vembu.

The Office Action stated that "it exits the first service provider and monitors the pilot strength and the pilot received power of the other providers to find a better service provider system" is shown in figs.4 and 5 in Achour. It can be read that the first service provider is different from the better service provider. Therefore, Achour does not disclose "*a unit that determines, for each of the other communication device, a communication data size that a communication performance of a communication between the other communication device in a first communication mode exceeds a communication performance of communication in a second communication mode and set the determined communication data size as a threshold for the other communication device.*"

The Office Action stated that Achour discloses "if the first performance level falls below a first threshold or the second performance level falls below a second threshold, a timer started." However, Achour does not disclose comparing the first performance level with the second performance level. A first threshold level compared with the first performance level, and a second threshold level compared with the second performance level, are different threshold values. Further, with Achour, it is determined whether the first performance level is above the first threshold level or not, and whether the second performance level is above the second threshold level or not. Here, the results of the two determinations have no relationship to each other. Therefore, Achour does not disclose "*a unit that determines, for each of the other communication device, a communication data size that a communication performance of a communication between the other communication device in a first communication mode exceeds a communication performance of communication in a second communication mode and set the determined communication data size as a threshold for the other communication device*" and "*a unit that selects one of the communication modes that the corresponding communication performance exceeds the communication performance of the other communication mode in an actual communication under a particular communication data size between a particular communication device under a particular communication condition.*"

Achour discloses that "if both of these levels are below respective thresholds for over eight seconds, the phone switches to another network" in summary. However, none of "these levels" corresponds to any communication modes. Achour discloses that "... after the phone has initially connected to a CDMA wireless network, monitoring a level of total power received by the phone... If the power level remains below the threshold level... the dual-mode or dual-band phone switches to an AMPS or other network." However, Achour does not disclose that a communication performance of AMPS or other network is measured. Achour discloses "the phone has initially connected to a CDMA wireless network." Therefore, Achour does not disclose "*a unit that selects one of the communication modes that the corresponding communication performance exceeds the communication performance of the other communication mode in an actual communication under a particular communication data size between a particular communication device under a particular communication condition.*"

Hence, the noted features of claim 15 are distinction over Achour. The noted features also are distinction over Vembu as evidenced, e.g., by the Office Action. That is, the Office Action does not assert Vembu as disclosing the noted features.

Claims 16-17 depend from Claim 15. A basis for how Achour is deficient vis-à-vis Claims 15 has been noted above. The Office Action does not rely upon Vembu to compensate for these deficiencies. Hence, the noted feature of Claims 15 also is a distinction over Vembu.

Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggested each and every element of the claimed invention. In view of the distinction of Claim 15 noted above, at least one claimed element is not present in the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis Claims 15. Claims 16-17 ultimately depend from claim 15, and so at least similarly distinguish over the asserted combination of references.

#### **INDEPENDENT CLAIM 18**

As an example, independent claim 18 recites (among other things) a feature of:

..."  
*measuring performances of communication between the other communication device in a plurality of different communication modes under a plurality of different communication conditions respectively, for each of the other communication devices;*  
*determining, for each of the other communication devices, a communication*

*condition that a communication performance of communication between the other communicating device in one of the communication modes exceeds a communication performance of communication in the other communication mode, for each other of the other communication devices; and*

*selecting a communication mode for actually communicating with a particular other communication device, in which its communication performance under a communication condition of the actual communication exceeds a communication performance of communication in the other communication mode*

...

As will be explained below, at least these features of claim 18 are a distinction over Achour, and thus over its combination with Vembu.

The Office Action stated that "it exits the first service provider and monitors the pilot strength and the pilot received power of the other providers to find a better service provider system" is shown in figs.4 and 5 in Achour. It can be read that the first service provider is different from the better service provider. Therefore, Achour does not disclose "*measuring performances of communication between the other communication device in a plurality of different communication modes under a plurality of different communication conditions respectively, for each of the other communication devices.*"

The Office Action stated that Achour discloses "if the first performance level falls below a first threshold or the second performance level falls below a second threshold, a timer started." However, Achour does not disclose comparing the first performance level with the second performance level. A first threshold level compared with the first performance level, and a second threshold level compared with the second performance level, are different threshold values. Further, with Achour, it is determined whether the first performance level is above the first threshold level or not, and whether the second performance level is above the second threshold level or not. Here, the results of the two determinations have no relationship to each other. Therefore, Achour does not disclose "**determining, for each of the other communication devices, a communication condition that a communication performance of communication between the other communicating device in one of the communication modes exceeds a communication performance of communication in the other communication mode, for each other of the other communication devices**" and "**selecting a communication mode for actually communicating with a particular other**

*communication device, in which its communication performance under a communication condition of the actual communication exceeds a communication performance of communication in the other communication mode."*

Achour discloses that "if both of these levels are below respective thresholds for over eight seconds, the phone switches to another network" in summary. However, none of "these levels" corresponds to any communication modes. Achour discloses that "... after the phone has initially connected to a CDMA wireless network, monitoring a level of total power received by the phone... If the power level remains below the threshold level... the dual-mode or dual-band phone switches to an AMPS or other network." However, Achour does not disclose that a communication performance of AMPS or other network is measured. Achour discloses "the phone has initially connected to a CDMA wireless network." Therefore, Achour does not disclose "**selecting a communication mode for actually communicating with a particular other communication device, in which its communication performance under a communication condition of the actual communication exceeds a communication performance of communication in the other communication mode.**"

Hence, the noted features of claim 18 are distinction over Achour. The noted features also are distinction over Vembu as evidenced, e.g., by the Office Action. That is, the Office Action does not assert Vembu as disclosing the noted features.

Accordingly, withdrawal of the rejection is respectfully requested.

### **New Claim**

Again, new claims 24-28 have been added. As for new claims 24-28 not argued above, the following comments are provided.

A feature at the least that distinguishes new independent claim 24 over the applied art is "communicating with the other communication device to evaluate communication speed, the communication being performed in a plurality of different communication modes respectively, by varying communication data size." New claims 25-28 ultimately depend from claim 24, and so at least similarly distinguish over the asserted combination of references.

### **Conclusion**

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Atty Docket No.: 1046.1209  
App. Ser. No.: 09/501,716

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 19-3935.

Respectfully submitted,  
STAAS & HALSEY LLP

/Mehdi D. Sheikerz/

Date: May 10, 2010 By: \_\_\_\_\_

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